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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TRAN, PHUC H

ART UNIT PAPER NUMBER

2616

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/474,935

Applicant(s)

UMANSKY, ILYA

Examiner

PHUC H. TRAN

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 7, 15-17 and 19-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 and 15-17 is/are allowed.
- 6) ☒ Claim(s) 1, 19, 24, 26, 27, 31, 33, 34, 38, 40, 41, 45, 47, 48 and 52 is/are rejected.
- 7) ☒ Claim(s) 20-23, 25, 28-30, 32, 35-37, 39, 42-44, 46, 49-51, 53 and 70 is/are objected to.
- 8) ☒ Claim(s) 54-69 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to the applicant's response filed 11/17/2005. Claims 1, 7, 15-17, & 19-70 are pending in the application. Detailed action is followed:

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 7, 15-17, 19-53 and 70, drawn to convert a packet to fax, classified in class 370, subclass 352.
  - II. Claims 54-69, drawn to transmit email message to one or more intended recipients, classified in class 370, subclass 432.

The inventions are distinct, each from the other because of the following reasons:

Inventions I & II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because mentioned above. The subcombination has separate utility such as I-II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different sub-classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Newly submitted claims directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims are directed to transmit email messages to multiple destination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 54-69 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1,19,24,26,27,31,33,34,38,40,41,45,47,48, and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Maeda (Pub No. 2005/0021647).

- With respect to claim 1, Maeda teaches an email/fax communication system for use in a packet switching network environment (an image communication system include electronic-mail as Fig. 1) including a mail server (3 and 5 in Fig. 1) for storing email messages;

- a network processing device (1, and 2 in Fig. 1) for converting a first email message from the mail server to facsimile information (e.g. block 7 and 13 in Fig. 1), and

- transmitting the facsimile information to one or more remote facsimile devices (e.g. printer 14 in Fig. 1), where the network processing device detects a failure in the transmission of the facsimile information to at least one of the remote facsimile devices (paragraph 28 and 29) and

- transmits a second emails message including at least a first portion of the first email message to the mail server responsive to the detected failure (paragraph 28).

- With respect to claims 19,27,34,41, & 48, Maeda teaches wherein the first portion of the first email message included within the second email message corresponds to the facsimile information that was unsuccessfully transmitted as a result of the failure (e.g. paragraph 57).

- With respect to claims 24,31,38,45, & 52, Maeda also teaches wherein the network processing device detects another failure (e.g. at these steps S208, S209 and S210 determine

errors at receiving side) in the transmission of the facsimile information corresponding to at least one of the remote facsimile devices and transmits a third email message including at least a portion of the first email message to the mail server responsive to the other detected failure (e.g. the generating message error from block 15 to block 17 in Fig. 1).

- With respect to claims 26, 33, 40, and 47, Maeda teaches a device (block 2 in Fig. 1) comprising: a first interface (the transmission 17 and reception 12 in Fig. 1) for exchanging one or more email messages with a mail server (5 in Fig. 1); a translator configured to convert a first email message from the mail server into facsimile information (block 13 in Fig. 1); and a second interface for transmitting the facsimile information, to one or more remote facsimile devices (e.g. block 13 transmits to printer), where the first interface transmits a second email message that includes at least a portion of the first email message to the mail server responsive to a failure in the transmission of the information to at least one of the remote facsimile devices (paragraph 28 and 29).

#### ***Allowable Subject Matter***

6. Claims 7 and 15-17 are allowed.
7. Claims 20-23, 25, 28-30, 32, 35-37, 39, 42-44, 46, 49-51, 53 and 70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 19, 24, 26, 27, 31, 33, 34, 38, 40, 41, 45, 47, 48, and 52 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Herbst (U.S. Patent No. 4941170) discloses facsimile transmissions system.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUC H. TRAN whose telephone number is (571) 272-3172. The examiner can normally be reached on M-F (8-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHI PHAM can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phuc Tran  
Assistant Examiner  
Art Unit 2664

P.t  
March 31, 2006

  
CHI PHAM  
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4/3/06